



Atty Dkt No. 8325-0007.20
(S7-US3)
USSN: 09/941,450
PATENT

AX 1600

RECEIVED
SEP 23 2003
TECHNICAL SERVICES

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on

9/12/03
Date

Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Case et al.

Confirmation No.: 6791

Serial No.: 09/941,450

Art Unit: 1631

Filing Date: August 28, 2001

Examiner: J. Brusca

Title: GENE IDENTIFICATION

AMENDMENT TRANSMITTAL LETTER

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing is an amendment in the above patent application in response to the Office Action of July 16, 2003.

- ☐ Applicants request an extension of time for * months. Enclosed is a check to cover the \$* fee.
- ☐ No additional fee is required.
- ☒ Also enclosed: IDS, Check for IDS and Return Postcard.

Atty Dkt No. 8325-0007.20
 (S7-US3)
 USSN: 09/941,450
 PATENT

No. of Claims After Amendment			Most Claims Previously Paid		Extra Claims		Additional Fee		
A. Total Claims	24	-	30	=	0	x	\$18	=	\$0
B. Ind. Claims	1	-	3	=	0	x	\$84	=	\$0
C. If amended to contain multiple dependent claims, add 280							\$280	=	\$0
D. Total Amendment Fee (Total of A, B & C)								=	
E. If small entity, 50% reduction of Total Amendment Fee (50% of D)								=	
F. Total Amendment Fee (D minus E)								=	\$0

___ A check for \$ * to cover the extension of time fee and extra claims fee is attached.

___ Charge \$ to Deposit Account No. 18-1648.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: Sept 12, 03

By: D. Pasternak

Dahna S. Pasternak
 Registration No. 41,411
 Attorney for Applicants

ROBINS & PASTERNAK LLP
 1731 Embarcadero Road, Suite 230
 Palo Alto, CA 94303
 Telephone: 650-493-3400
 Facsimile: 650-493-3440

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

To:
DAHNA S. PASTERNAK
ROBINS & PASTERNAK LLP
545 MIDDLEFIELD ROAD
SUITE 180
MENLO PARK, CA 94025

PCT

NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL SEARCH REPORT OR THE DECLARATION

(PCT Rule 44.1)

Applicant's or agent's file reference 8325-0007.60 <i>SAB 002/03 WO</i>		Date of Mailing (day/month/year) 23 JUN 2003
International application No. PCT/US02/27310		International filing date (day/month/year) 27 August 2002 (27.08.2002)
Applicant SANGAMO BIOSCIENCES, INC.		<i>8325-0007.60</i>

1. ☒ The applicant is hereby notified that the international search report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

Where? Directly to the International Bureau of WIPO, 34, chemin des Colombettes
1211 Geneva 20, Switzerland, Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. ☒ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

☒ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Reminders**

Shortly after 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90 bis.1 and 90 bis.3, respectively, before the completion of the technical preparations for international publication.

Within 19 months from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later); otherwise the applicant must, within 20 months from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

In respect of other designated Offices, the time limit of 30 months (or later) will apply even if no demand is filed within 19 months.

See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

Name and mailing address of the ISA/US Commissioner for Patents Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230	Authorized officer John S. Brusca Telephone No. 703 308-0196
--	--

Form PCT/ISA/220 (April 2002)

(See notes on accompanying sheet)

RECEIVED

JUL - 2 2003

ROBINS & PASTERNAK LLP

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 8325-0007.60	FOR FURTHER ACTION	see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.
International application No. PCT/US02/27310	International filing date (<i>day/month/year</i>) 27 August 2002 (27.08.2002)	(Earliest) Priority Date (<i>day/month/year</i>) 28 August 2001 (28.08.2001)
Applicant SANGAMO BIOSCIENCES, INC.		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 5 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the Report

a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing:

☐ contained in the international application in written form.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority in written form.

☐ furnished subsequently to this Authority in computer readable form.

☐ the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

☐ the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

2. ☐ **Certain claims were found unsearchable** (See Box I).

3. ☒ **Unity of invention is lacking** (See Box II).

4. With regard to the **title**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the **drawings** to be published with the abstract is Figure No. _____

☐ as suggested by the applicant.

☐ because the applicant failed to suggest a figure.

☐ because this figure better characterizes the invention.

☒ None of the figures

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US02/27310

Box I Observations where certain claims were found unsearchable (Continuation of Item 1 of first sheet)

This international report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. ☐ Claim Nos.:
because they relate to subject matter not required to be searched by this Authority, namely:
2. ☐ Claim Nos.:
because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:
3. ☐ Claim Nos.:
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

Box II Observations where unity of invention is lacking (Continuation of Item 2 of first sheet)

This International Searching Authority found multiple inventions in this international application, as follows:
Please See Continuation Sheet

1. ☐ As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims.
2. ☐ As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.
3. ☒ As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.: generic claims 1-14, 18, and 26-30 and species of second molecule that is protein (claim 15), species of cell that is a human cell (claim 19), and two species of phenotype that are cell growth (claim 23 in part) and expression of an RNA molecule (claim 24).
4. ☐ No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

☒
☐

The additional search fees were accompanied by the applicant's protest.

No protest accompanied the payment of additional search fees.

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US02/27310

A. CLASSIFICATION OF SUBJECT MATTER

IPC(7) : G06F 19/00; C12Q 1/68

US CL : 702/19; 435/6

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 702/19; 435/6

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)
Please See Continuation Sheet

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X — Y	WO 00/42219 A1 (SANGAMO BIOSCIENCES, INC.) 20 July 2000 (20.07.00), pages 11, 18, 20, 21, 24, 38.	1, 2, 4-12, 14, 18, 19, 24, 26, 27 3, 13, 15, 23, 28, 29, 30
Y	HEIX et al. Mitotic silencing of human rRNA synthesis: inactivation of the promoter selectivity factor SL1 by cdc2/cyclin B-mediated phosphorylation. EMBO Journal. 1998, Vol. 17, Number 24, pages 7373-7381, especially page 7373.	3
Y	HAGMANN et al. The VP16 Paradox: Herpes Simplex Virus VP16 Contains a Long-Range Activation Domain but within the Natural Multiprotein Complex Activates Only from Promoter-Proximal Positions. Journal of Virology. August 1997, Vol. 71, Number 8, pages 5952-5962, especially page 5952.	13, 15
Y	LIU et al. Transcription factor EGR-1 suppresses the growth and transformation of human HT-1080 fibrosarcoma cells by induction of transforming growth factor beta-1. Proc. Natl. Acad. Sci. USA. October 1996, Vol. 93, pages 11831-11836, especially page 11831.	23

☒ Further documents are listed in the continuation of Box C.

☐ See patent family annex.

Special categories of cited documents:	
"A" document defining the general state of the art which is not considered to be of particular relevance	"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"E" earlier application or patent published on or after the international filing date	"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"O" document referring to an oral disclosure, use, exhibition or other means	"&" document member of the same patent family
"P" document published prior to the international filing date but later than the priority date claimed	

Date of the actual completion of the international search

03 March 2003 (03.03.2003)

Date of mailing of the international search report

23 JUN 2003

Name and mailing address of the ISA/US

Commissioner of Patents and Trademarks
Box PCT
Washington, D.C. 20231

Facsimile No. (703)305-3230

Authorized officer

John S. Brusca

Telephone No. 703 308-0196

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty and of the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wishes the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended ?

The claims only.

The description and the drawings may only be amended during international preliminary examination under Chapter II.

When ? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How ? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

What documents must/may accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confounded with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

NOTES TO FORM PCT/ISA/220 (continued)

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

The statement should be brief, it should not exceed 500 words if in English or if translated into English.

It should not be confounded with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It should not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report, may be made only in connection with an amendment of that claim.

In what language ?

The amendments must be made in the language in which the international application is published. The letter and any statement accompanying the amendments must be in the same language as the international application if that language is English or French; otherwise, it must be in English or French, at the choice of the applicant.

Consequence if a demand for international preliminary examination has already been filed ?

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

Consequence with regard to translation of the international application for entry into the national phase ?

The applicant's attention is drawn to the fact that, where upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.